

REMARKS

This paper is filed in response to the Official Action, issued by the U.S. Patent and Trademark Office (“the Office”) on February 28, 2006, wherein an Election of Species requirement was imposed.

In the Official Action, the Office asserts that the application contains claims directed to thirteen patentably distinct species: Species I (figures 1 and 2); Species II (figures 3 and 4); Species III (figures 5 and 6); Species IV (figures 7 and 8); Species V (figures 9-13); Species VI (figures 14 and 15); Species VII (figure 26); Species VIII (figure 27); Species IX (figures 28-29); Species X (figures 32-34); Species XI (figures 35-38); Species XII (figures 39-41); and Species XIII (figures 42 and 43). See Official Action, page 2. The Office further asserts that the application contains claims directed to twelve patentably distinct sub-species: Species A (figure 16); Species B (figure 17); Species C (figure 18); Species D (figures 19A and 19B); Species E (figure 20); Species F (figure 21); Species G (figure 22); Species H (figure 23); Species I (figure 24); Species J (figure 25); Species K (figure 30); and Species L (figure 31). See Official Action, pages 2-3.

The election of a single species is required. In response, **applicants provisionally elect Species V, drawn to Figs. 9-13**. However, this election is made **with traverse**, as outlined herein. Applicants request the Office to recast the election requirement such that claims directed to Species V (Figs. 9-13), Species VI (Figs. 14 and 15), and Species IX (Figs. 28 and 29) are all examined. Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39, 44-46, 49-54, and 56 read on the elected species. If the Office agrees to recast the election requirement as requested herein, claims 17 and 57-63, directed to Species VI and IX, should also be examined.

The requirement is traversed because the Office has not issued a proper election requirement. For example, the Office has failed to prove that “there would be a serious burden on the examiner if restriction is not required,” as required in MPEP § 808.01(a) (emphasis added). Species V, VI, and IX of the proposed recast election are all directed to a sheet material dispenser that is or can be mounted on the non-writing end of a writing instrument. As disclosed in the specification, the major difference between the embodiments is the structure connecting the tape flag dispenser to the writing utensil. In Species V, the dispenser is releasably attached. In referring to Species VI, the specification notes, “[i]n other versions of the refillable add-on flag dispenser, the cartridge base can be integrally attached onto an end of a writing instrument [].” Specification at ¶ 74. The specification introduces Species IX as “FIG. 28 and 29 illustrate yet another technique for connecting a flag dispenser to a writing instrument.” *Id.* at ¶ 106. Each of the alleged species have many elements in common, including a dispenser base with an upstanding partially cylindrical inner shell, a housing disposed over the inner shell, a slit in the housing, and a set of tape flags disposed in the housing and accessible through the slit. It is submitted that any complete prior art search of elected Species V will largely encompass a prior art search to any of Species VI and IX. Accordingly, no serious burden can be shown.

Further, “the examiner must show by appropriate explanation” how there will be a serious burden. MPEP § 808.02 (emphasis added). The only reasoning provided in the Official Action is deficient. The Office only states that the species are distinct because “the various embodiments show differing structures...” The Office makes no allegations that a serious burden will be imposed on the examiner to search any of the alleged species or sub-species, much less to search Species V, VI, and IX of the proposed recast election.

Because search and examination of Species V, VI, and IX can be performed without a serious burden on the Office, requiring the applicant to prosecute those claims in separate patent applications would waste the time, effort, and resources of both the applicant and the Office. Furthermore, the applicant will likely incur additional prosecution costs associated with filing multiple divisional applications and the Office will be required to perform duplicative searches if the election requirement is maintained. Thus, the recasting of the election requirement such that the elected species includes Species V, VI, and IX will actually reduce the burden on the Office and on the applicants.

Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39, 44-46, 49-54, and 56 read on the elected species. Claims 3-6, 8, 13, 17, 19, 22, 23, 25-38, 40-43, 47, 48, 55, and 57-77 do not read on the elected species and consequently have been withdrawn. It is respectfully submitted, however, that independent claim 1 is generic to Species I, II, V, VI, VII, VIII, IX, XII, and XIII, and that independent claim 45 is generic to Species I, II, III, IV, V, VII, and VIII. Applicant will be entitled to consideration of claims directed to such species upon the allowance of such a generic claim. Again, if the Office agrees to recast the election requirement as requested, then claims 17 and 57-63 should also be examined.


CONCLUSION

In view of the foregoing, the applicant respectfully requests reconsideration and withdrawal of the election requirement imposed between the claims falling within Species V, VI, and IX. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney. An action on the merits of all the claims and a Notice of Allowance thereof are respectfully requested.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
312/474-6300

By:



Russell C. Petersen
Registration No. 53,457
Attorney for Applicants

March 28, 2006